

REMARKS

This application has been reviewed in light of the Office Action dated December 2, 2005. Claims 1-59, 61, and 66-75 are presented for examination, of which Claims 1, 3, 5, 33, 58, 61, 66, 69, 70, 71, 74, and 75 are in independent form and have been amended as discussed below. Claim 2 has also been amended for consistency with Claim 1. Claims 55 and 63-65 have been cancelled without prejudice or disclaimer of subject matter. Favorable reconsideration is requested.

The Examiner's Interpretation of the Claims

Paragraph 2 of the Office Action provides the Examiner's interpretation of certain claims, in response to which Applicant has the following comments.

Applicant respectfully disagrees that the phrase "adapted to" in Claims 3, 4, 61, and 66 introduces an "intended use" of the claimed invention. Rather, that phrase introduces functional language that describes a configuration of an apparatus prior to its actually being used, e.g., what a computer-implemented apparatus is programmed to do. By contrast, *Ex parte Masham*, the case cited by the Examiner, involved a claim limitation that specified a particular manner in which a device would be positioned during operation ("said mixing means being stationary and completely submerged in the developer material"). See, M.P.E.P. § 2114.

Accordingly, Applicant requests that the Examiner properly interpret and consider the claim language in question.

Rejections under 35 U.S.C. § 112

Claim 1, 5, 33, 58, 61, 63, 66, 69-71, 74, and 75 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejection of Claim 63 has been rendered moot by the cancellation of that claim. Applicant respectfully traverses the remaining rejections for the following reasons.

The relevant question under 35 U.S.C. § 112, second paragraph is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” M.P.E.P. § 2173.02. “Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Id.*

In paragraph 4a, the Examiner takes issue with the language that he and Applicant’s representative agreed to during the telephonic interview of May 26, 2005: “wherein the user-defined parameters are not used to perform a search for content.”<sup>1</sup> The Examiner states that “it is not clear to one of ordinary skill how Applicant’s system can guarantee that a user will not use self-imposed financial restraints to guide a search for content or that the system can detect such use as this is a mental step.” (Office Action at page 3).

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<sup>1</sup> See, Interview Summary mailed May 27, 2005, in which the Examiner states: “Independent Claims will be amended to include the following language: . . . wherein the user-defined parameters are not used to perform a search for the content. The added language differentiates Applicant’s claims from the prior art as Dedrick uses user-defined parameters to search for content.”

As understood by Applicant, the Examiner is suggesting that a user might perform a mental step of searching for content using the same parameters set in the setting step and that Applicant's system would not be able to prevent or detect such mental step. However, there is no requirement in 35 U.S.C. § 112, second paragraph, or elsewhere in the patent laws and rules, U.S.P.T.O. rules, or case law, that the claimed invention be capable of preventing or detecting infringement, or preventing or detecting a mentioned mental step, as the Examiner seems to suggest. Moreover, the hypothetical actions, whether mental or physical, of a user are irrelevant to whether the claims are sufficiently definite to one of ordinary skill in the art.

As discussed above, the relevant legal issue is whether one of ordinary skill in the art would be able to ascertain the scope of the claims. It is respectfully submitted that one of ordinary skill in the art would readily be able to ascertain the meaning of the phrase "wherein the user-defined parameters are not used to perform a search for the content," especially in view of Applicant's disclosure. It is therefore believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, reconsideration and withdrawal of these rejections is requested.

In paragraph 4b, the Examiner states that the removal of the clause "selecting content through the network" renders Claims 5 and 33 indefinite. The Examiner asserts that "to one of ordinary skill there is necessarily an authorization . . . prior to 'accessing' otherwise a user will be charged for content that he or she does not desire." (Office Action at page 4).

Again, the relevant question is whether one of ordinary skill in the art would be able to ascertain the scope of the claim. Claim 5 recites, *inter alia*, "accessing, through

the network, selected content that requires a fee to be accessed, based on at least one predefined user-preference, specified by a user, pre-authorizing payment for content requiring a fee, and without obtaining further user input specifying a payment authorization or a payment method selection prior to the accessing.” It is submitted that one of ordinary skill in the art would readily understand the meaning of this phrase, especially in view of Applicant’s disclosure, whether or not the claim positively recites “selecting content.” Moreover, it is apparent that the Examiner’s interpretation of the claim, in which the user supposedly would receive undesired content, is simply erroneous, or at least irrelevant, especially since Claim 5 explicitly recites that the content is selected content (whether desired or not). Claim 5 therefore meets the requirements of 35 U.S.C. § 112, second paragraph. Similar reasoning applies to the other claims rejected on these grounds. Accordingly, reconsideration and withdrawal of these rejections is respectfully requested.

Finally, the Examiner contends that there is insufficient antecedent basis for the term “selected content” in line 3 of Claim 5.

The M.P.E.P. provides the following guidance regarding when a rejection on this ground is proper:

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to “said lever” or “the lever,” where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference. Similarly, if two different levers are recited earlier in the claim, the recitation of “said lever” in the same or subsequent claim would be unclear where it is uncertain which of the two levers was intended.

M.P.E.P. § 2173.05(e)(emphasis added). It is submitted that the meaning of the term “selected content,” at line 3 of Claim 5, would be clear to one of ordinary skill in the art,

and indeed, the Examiner has not given any reason why this term would be unclear. Moreover, the term in question does not refer back to an earlier recitation. Rather, it is the initial use of that term in the claim, so, in fact, there is no lack of antecedent basis. “The mere fact that the body of a claim recites additional elements which do not appear in the claim’s preamble does not render the claim indefinite under 35 U.S.C. 112, second paragraph.” *Id.*

It is submitted that Claim 5 is clear as it stands and the scope of the claim would be readily understood by those of skill in the art. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

If the Examiner still refuses to withdraw the Section 112 rejections, despite the foregoing remarks, he is respectfully requested to cite U.S.P.T.O. rules or case law which he believes supports his positions.

#### Rejections Under 35 U.S.C. § 103

Claims 1, 3, 5-15, 17-26, 28, 29, 31-37, 39-42, 46-56, 58, and 63-75 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,073,124 (“Krishnan”) in view of U.S. Patent No. 5,878,141 (“Daly”); Claims 2, 4, 14, 16, 27, 43-45, and 65 as obvious over Krishnan in view of Daly and U.S. Patent No. 5,969,748 (“Casement”); Claims 7, 30, 35, and 57 as obvious over Krishnan in view of Daly and U.S. Patent No. 6,058,381 (“Nelson”); Claim 38 as obvious over Krishnan in view of Daly and U.S. Patent No. 5,500,513 (“Langhans”); and Claims 58, 59, and 61 as obvious over Krishnan in view of Daly and U.S. Patent No. 6,282,653 (“Berstis”).

Krishnan relates to facilitating the purchase and delivery of electronic content using a secure system. Daly relates to an electronic purchasing system that determines which of the payment methods registered by the user are accepted by the merchant (see Fig. 2).

Krishnan and Daly, no matter how they hypothetically may be combined, do not teach or suggest “setting user-defined parameters specified by the user to accept all fees below a predetermined amount, the predetermined amount defining a threshold for determining whether an individual fee should be accepted, without regard to a cumulative total of the fees,” as recited in Claim 1. As discussed throughout the prosecution of this application, the use of a predetermined threshold makes it more convenient for the user to purchase numerous low-cost content items, such as articles from news websites, etc.

The Examiner characterizes Krishnan and Daly as follows.

Krishnan et al. teach providing payment for content using a digital wallet. However, Krishnan et al. do not specifically recite digital wallets with spending controls. Daly et al. teach user imposed spending controls on a digital wallet . . . including the acceptance (or preauthorization) of all goods and service fees below a preset amount . . . (i.e. account limit prior to card expiration date) . . .

(Office Action at page 6). However, to equate a credit card account limit to the claimed predetermined amount is disingenuous at best. First, an account limit is not a “user-defined [parameter] specified by the user.” Second, with a credit card account, the acceptance of fees is based on the account limit minus the current balance of the account (i.e., the account limit minus the accumulated fees) which, again, is not a “user-defined parameters specified by the user.” Daly’s user-created spending limits likewise do not correspond to the predetermined amount for this second reason, i.e., acceptance is based on

the user-created spending limit minus the current account balance. To make this distinction even more clear, Claim 1 has been amended to recite: “the predetermined amount defining a threshold for determining whether an individual fee should be accepted, without regard to a cumulative total of the fees.” Claims 3, 66 and 69 have been similarly amended. Nothing has been found or pointed out in Krishnan and Daly that would teach or suggest these features.

The combination of Krishnan and Daly also does not teach or suggest “accessing, through the network, selected content that requires a fee to be accessed, based on at least one predefined user-preference, specified by a user, pre-authorizing payment for content requiring a fee, and without obtaining further user input specifying a payment authorization or a payment method selection,” as recited in Claim 5. Claims 33, 58, 61, 66, 70, 71, 74, and 75 similarly recite this feature.

In Krishnan, the user must select a payment method to complete the purchase of the selected content (see Figs. 14 and 16 and col. 20, line 53 through col. 21, line 21), which may require the user to enter a password for the selected credit card (see Fig. 15). Then the user must verify their intention to make the purchase (see Fig. 17). Likewise, in Daly, the user must select a payment method to complete the purchase of the selected content (see col. 12, lines 53-67).

The remaining references cited by the Examiner do nothing to remedy the deficiencies of Krishnan and Daly with respect to the features discussed above. Accordingly, all of the independent claims are submitted to be patentable over the cited references.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

  
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